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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,752	04/17/2001	James D. Bennett	P93-00-AC	8896

7590 09/24/2003

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EXAMINER
KNEPPER, DAVID D

ART UNIT	PAPER NUMBER
2654	11

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/837,752	BENNET ET AL	
	Examiner	Art Unit	
	David D. Knepper	2654	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 June 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *8* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. Applicant's correspondence filed on 20 June 2003 (paper #10) has been received and considered. Claim 11 is pending. Claims 1-10 have been canceled.

2. The IDS of paper #5 (17 April 2001) failed to follow 37 CFR 1.98 and 1.97 has now been submitted using the recommend PTO Form 1449 as paper #8. The applicant indicates that copies of the listed references were not provided because they come from applications which are relied upon for an earlier filing date under 35 USC 120.

Applicant's reference to MPEP 609(I)(A)(2) in paper #10 is not wholly accurate. There is no requirement for re-consideration of previous issues in parent applications as this would only be proper by way of Reissue or Reexamination. However, it is routine for the art considered in parent applications to be considered in a continuation. The most pertinent sentence of MPEP 609(I)(A)(2) is: "**Such information need not be resubmitted in the continuing application unless the applicant desires the information to be printed on the patent.**"

Thus, the applicant did not need to provide an IDS unless the applicant wanted the listed documents to be printed on any resulting patent.

The initial copies of PTO Form 892 was entered by PTO clerical staff as an IDS but the applicant made no mention of them. There is no provision in the rules to allow the applicant to utilize the 892 forms provided by Examiners in one application to be printed in another application so the applicant was simply reminded of the normal procedure under applicable rules.

Confusion could result in a number of ways if an application would be allowed with Form 892's from other applications. It is possible that the different serial numbers would not be noticed and the listed documents would be printed on any resulting patent (however, they would

be erroneously construed as cited by the examiner in the instant application). It is also possible that the different serial numbers would be noticed and that the forms would be removed to be matched with the application indicated thereon. Another likely result is that the different serial numbers would be noticed by the printer and the case sent back to the Examiner to explain the irregularity.

It is therefore suggested that the applicant strictly adhere to rules 37 CFR 1.97 and 1.98 when submitting an IDS to avoid problems and misunderstandings in the future.

The Leffler reference was lined through to prevent it from being listed twice since it was previously included on the Examiner's form 892. 5,329,602 was changed to 5,329,608 under the assumption that this corrects a typing error.

3. The incorporation of patents 5,926,787 and 5,815,639 is improper because they also incorporate by reference (see MPEP 608.01(p)). The applicant must extract the essential material from the references and place it in the instant application.

The applicant's arguments that such incorporations are proper because the instant application is a continuation is NOT correct. MPEP 608.01(p) makes no distinction between any particular status of an application regarding the incorporation of essential material. No essential material may be incorporated by reference to another patent or application that also incorporates essential material. The exception is towards the incorporation of non-essential material and the fact that the instant application is a continuation has no bearing on such incorporations.

The applicant fails to indicate that the incorporated material is non-essential. In fact, the applicant states that the incorporated materials are identical to the instant application. If this is

true, then no incorporation was necessary. Based on the applicant's admission that the materials are "identical," the incorporations are redundant and should be removed. If, contrary to the statement that applications are identical, there are actually slight variations that the applicant deems essential, then the information must be extracted and inserted into the instant application.

Abstract

4. The Abstract of the Disclosure is accepted.

Claims

5. The applicant's arguments regarding the rejection under 35 USC 101 is convincing. The patent claims contain all of the limitations of the instant claim 11. However, the applicant's arguments show that the instant claim is significantly broader in scope that the patent claims and therefore, is not identical in scope.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 11 is rejected under 35 U.S.C. § 103 as being unpatentable over Stentiford (5,384,701).

Claim 11 is taught or suggested by Stentiford's figure 1:

"receiving into a transcription system, in real-time, representations of words spoken in a first language, during a testimonial proceeding" (his speech input 3 and also alternative input: text in first language 5);

"converting, in real-time, said representations to text" (his speech recognition 4 – see also col. 7, line 41 where speech-to-text);

"translating...the text in the first language to text in a second language (taught by his translating phrases from a first language into a second language, col. 1, lines 52-53 and his); and

"communicating the text in the second language to a terminal for real-time display" (suggested by his alternative text output in second language 12, fig. 1 – since he also teaches audible output via speech synthesis as an alternative, it is considered inherent with his inclusion of a standard computer such as the IBM PC XT (col. 2, line 40) that the text output would be a visual display of said text – he teaches the use of first and second terminals to provide two way communication in column 6, lines 41-53).

It is noted that Stentiford does not explicitly teach that his translation system is operating "during a testimonial proceeding". However, he clearly recognizes the usefulness of translation systems as an aid for professional translations... and as a needed improvement for 'real-time' speech operation (col. 1, lines 33-50). This background and summary indicates that it he desires

his language translation system to be used for professional applications requiring real-time operation. Thus, it would be obvious to use his device in any situation requiring a professional translation in real-time to include a "testimonial proceeding."

Prior Art

8. A new rejection under 35 USC 103 appears above in response to the arguments.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

TC2600 Fax Center
(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David D. Knepper whose telephone number is (703) 305-9644. The examiner can normally be reached on Monday-Thursday from 07:30 a.m.-6:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (703) 305-9645.

Any inquiry of a general nature or relating to the status of this application should be directed to customer service whose telephone number is (703) 306-0377.

David D. Knepper
Primary Examiner
Art Unit 2654
September 17, 2003